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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,276	11/10/1999	MATHIAS PAULS	3548.04-1	7769

7590 04/08/2003

PHILLIPS MOORE LEMPION AND FINLEY
SUITE 6
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EXAMINER

SERGEANT, RABON A

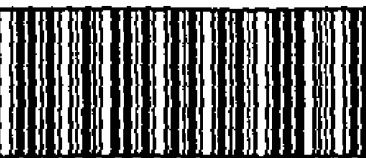
ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/437,276	Applicant(s) Pauls et al.	
	Examiner Rabon Sergent	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 21, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, and 9-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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1. Claims 2, 3, 11, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A Markush group has been inserted within claim 1 to specify that the propellant is selected from the group consisting of propane, butane, dimethyl ether, and combinations thereof.

Therefore, since Markush language, by definition, is closed to the inclusion of other species, the subject matter of the rejected claims, indicating that the propellant is a fluorocarbon, fails to further limit claim 1. Furthermore, within claim 16, the word, "propellent", remains misspelled.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-3, 6, and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauls ('412) in view of Falkenstein et al. ('313) and Friedman ('827).

Pauls discloses a storage stable polyurethane prepolymer composition, having an NCO content of 5 to 25 percent by weight, derived from aromatic polyisocyanates and polyols, including polyester polyols, which may be dispensed from a pressure can to yield a dimensionally stable foam. See abstract and columns 2-4.

4. Pauls is silent regarding the use of phosphorous containing compounds as softeners and is further silent regarding the use of phosphorous modified esters (claim 6); however, the use of each of these components within polyurethane foam formulations was known at the time of invention. Falkenstein et al. teach at column 3, lines 59-66 that the use of phosphorous containing compounds soften the foam and increase flame resistance. Despite applicants' arguments, the position is taken that urethane containing polyisocyanurates are similar to polyurethanes in terms of chemical composition and properties to the extent that one would have expected that additives useful in one composition would have been useful in the other. Friedman teaches the use of phosphorous containing polyols to provide flame resistance within polyurethanes. Despite applicants' response at page 8, the teachings of Friedman are considered to be relevant to the subject matter of instant claim 6, which is concerned with using phosphorous modified ester reactants in the production of the prepolymer.

5. Despite applicants' arguments, the position is ultimately taken that it would have been obvious to utilize known components for their known functions within polyurethane

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compositions. It has been held that it is *prima facie* obvious to utilize a compound for its known function (*In re Linder*, 173 USPQ 356; *In re Dial et al.*, 140 USPQ 244); therefore, one of ordinary skill in the art would have been motivated to utilize the known polyurethane foam components with the teachings of the Pauls reference, so as to obtain a pressure can dispensable prepolymer capable of yielding a foam having improved flame resistance and softness.

6. The examiner has considered applicants' arguments of January 21, 2003 and has again considered the declaration of July 26, 2002; however, the showings of the declaration are insufficient to remove the prior art rejection. Applicants' arguments and the showings of the declaration are not commensurate in scope with the subject matter of the instant claims. Despite applicants' arguments, the instant claims are not limited to the use of aromatic polyesters. The claims in no way require that an aromatic polycarboxylic acid be used to produce the polyester polyol. Additionally, it is not clear that unexpected results have been demonstrated in view of the teachings of the secondary references concerning flame retardancy. Lastly, applicants' remark at page 9, lines 2 and 3 is not understood, because the remark appears to be contrary to the subject matter of instant claim 6. The remark states that the polyester polyol is devoid of phosphate groups; however, claim 6 requires that the polyester polyol be phosphorous modified.

7. The disclosure is objected to because of the following informalities: The compound names within the tables of the examples appear to be incomplete. Furthermore, within line 22 of page 10, it appears that Desmophen PU 578 should be Desmophen PU 1578.

Appropriate correction is required.

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This objection was not addressed in the response to the previous Office action.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
April 5, 2003


RABON SERGENT
PRIMARY EXAMINER